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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,314	01/22/2004	Michael D. Ries	MLI-10	6544
7590	03/22/2006			
Daniel F. Justin 180 South 600 West Logan, UT 84321			EXAMINER SNOW, BRUCE EDWARD	
			ART UNIT 3738	PAPER NUMBER

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/763,314

Applicant(s)

RIES ET AL.

Examiner

Bruce E. Snow

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 February 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.  
4a) Of the above claim(s) 11, 19 and 21-39 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-10, 12-18, 20 and 40-42 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/24/04; 12/12/05.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election of Group I, Species 1 in the reply filed on 2/9/06 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 11, 19, 29, 38 and 39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention/species as indicated by applicant.

Additionally, claims 21-37 are withdrawn by the Examiner. Claim 21 requires a head component having a male friction fit portion with is drawn to a nonelected species.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 claims "wherein the transitional body region has a maximum height of less than thirteen millimeters when measured normal from the bottom surface of the flange to any part of the elongated stem portion. It is unclear how to delineate the between the transitional body region and the stem. This applies to all the prior art too.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 40-42 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. MPEP 2105 states: *If the broadest reasonable interpretation of the claimed invention as a whole encompasses a human being, then a rejection under 35 U.S.C. 101 must be made indicating that the claimed invention is directed to nonstatutory subject matter.*

Claim 40, "extending substantially inside the cavity of the femur" should be --for extending.--"; and "extending substantially inside the cavity of the femur" should be --for extending.--. Same for claims 41 and 42

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application

by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-3, 12-18, 20, 39-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Meulink et al (6,514,288).

Meulink et al teaches a prosthesis adapted for implantation against a resected surface on a proximal end of a femur and inside of an intramedullary cavity of the femur comprising:

- a femoral head component having an external bearing surface and a female friction fit portion (not shown, inherent);

- a femoral stem component comprising:

- a neck portion 22 having a proximal male friction fit portion, reversibly engagable with the female friction fit portion, and a distal neck body;

- a flange portion 24 distal and adjacent to the neck portion, attached to the distal neck body, having an upper portion and a bottom surface;

- a transitional body region, adjacent to the bottom surface of the flange portion and extending from the distal neck body;

- an elongated stem portion 36 extending distally from the transitional body region

and having a longitudinal axis that is orientated at an acute angle from the bottom surface of the flange portion; and

a distal end tip portion 50 adjacent and distal to the elongated stem portion;

wherein the transitional body region has a maximum height of less than thirteen millimeters when measured normal from the bottom surface of the flange to any part of the elongated stem portion.

Claims 1-9, 12-18, 20, 39-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Burke (6,179,877).

Burke teaches a prosthesis adapted for implantation against a resected surface on a proximal end of a femur and inside of an intramedullary cavity of the femur comprising:

a femoral head component 12 having an external bearing surface and a female friction fit portion;

a femoral stem component comprising:

a neck portion having a proximal male friction fit portion, reversibly engagable with the female friction fit portion, and a distal neck body;

a flange portion 18 distal and adjacent to the neck portion, attached to the distal neck body, having an upper portion and a bottom surface;

a transitional body region, adjacent to the bottom surface of the flange portion and extending from the distal neck body;

an elongated stem portion 14 extending distally from the transitional body region

Art Unit: 3738

and having a longitudinal axis that is orientated at an acute angle from the bottom surface of the flange portion; and

a distal end tip portion adjacent and distal to the elongated stem portion;

wherein the transitional body region has a maximum height of less than thirteen millimeters when measured normal from the bottom surface of the flange to any part of the elongated stem portion.

Regarding the boss, see elements 22, 34, 36, 30.

Claims 1-3, 10, 12-18, 20, 39-42 are rejected under 35 U.S.C. 102(b) as being anticipated by Hofman et al (EP 0539036).

Hofmann et al teaches a prosthesis adapted for implantation against a resected surface on a proximal end of a femur and inside of an intramedullary cavity of the femur comprising:

a femoral head 20 component having an external bearing surface and a female friction fit portion;

a femoral stem component comprising:

a neck portion 11 having a proximal male friction fit portion, reversibly engagable with the female friction fit portion, and a distal neck body;

a flange portion 12 distal and adjacent to the neck portion, attached to the distal neck body, having an upper portion and a bottom surface;

a transitional body region, adjacent to the bottom surface of the flange portion and extending from the distal neck body;

an elongated stem portion 25 extending distally from the transitional body region and having a longitudinal axis that is orientated at an acute angle from the bottom surface of the flange portion; and

a distal end tip portion adjacent and distal to the elongated stem portion;

wherein the transitional body region has a maximum height of less than thirteen millimeters when measured normal from the bottom surface of the flange to any part of the elongated stem portion.

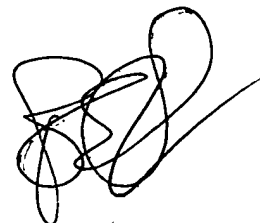
See flutes 18.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E. Snow whose telephone number is (571) 272-4759. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to be 'Bruce Snow', with a stylized, cursive-like script.

**BRUCE SNOW**  
**PRIMARY EXAMINER**